

In re Application of:  
Fenical et al.  
Application No.: 09/991,518  
Filed: November 16, 2001  
Page 9

PATENT  
Attorney Docket No.: UCSD1630-1

### **REMARKS**

These remarks are in response to the Office Action mailed June 27, 2005. Claims 1, 17-18, 20, 25-30 and 32 have been amended. Claim 31 has been canceled without prejudice and/or disclaimer, and claims 2-16 and 21-24 were previously canceled. The amendment to the claims does not add new matter nor raise new issues. Subsequent to the entry of this response, the pending claims are 1, 17-18, 20, 25-30 and 32.

An amended Sequence Listing is submitted herewith. The Sequence Listing shows sequences that were present in the subject application as filed and, therefore, does not add new matter.

Accordingly, all claims are in condition for allowance and such is respectfully requested.

### **Rejection Under 35 U.S.C. §112, second paragraph (indefiniteness)**

Claims 1, 17-18, 20 and 25-32 are rejected under 25 USC §112, second paragraph for failure to distinctly claim the subject matter that which Applicant regards as the invention. Applicants respectfully traverse this rejection as follows.

Pending claims 1, 17-18, 20, 25-30 and 32 have been amended. The claims have been amended to improve their form and do not add new matter. For example, as suggested in the Office Action, "marine Actinomycete" is replaced with "strain of *Salinospora*." Thus, pending claims are in condition for allowance. However, should the claims not be in condition for allowance, Applicants ask that the Examiner notify Applicant's representative by telephone to discuss any further amendments (e.g. Examiner's Amendment) which would put the claims in condition for allowance.

Accordingly, withdrawal of the rejection of the claims under 35 U.S.C. §112, second paragraph is respectfully requested.

In re Application of:  
Fenical et al.  
Application No.: 09/991,518  
Filed: November 16, 2001  
Page 10

PATENT  
Attorney Docket No.: UCSD1630-1

**Rejection Under 35 U.S.C. §112, first paragraph**

Claims 1, 17-18, 20 and 25-32 are rejected under 35 USC § 112, first paragraph for allegedly failing to describe in the specification subject matter in such a way as to enable one skilled in art to which it pertains to make and/or use the invention. Applicants respectfully reject this rejection as follows.

According to the Office Action, there is allegedly no deposit information described in the above-identified specification with regards to the specific strains of *Salinospora* which is the subject matter of the claimed invention.

Applicants submit herewith the Declaration of Dr. Paul Jensen, a co-inventor, in the above-identified application (see attached). In brief, Dr. Jensen states that: 1) SEQ ID NOs:3 and 4 are identical; and 2) SEQ ID NO:4 was derived from strain CNH646, which was deposited September 27, 2000 (ATCC No. PTA-2501); and SEQ ID NO:5 was derived from strain CNH898, which was deposited June 30, 2003 (ATCC No. PTA-5275).

According to the Office Action, the Declaration by Dr. Paul Jensen identifying the deposit of strains described in the above-identified application is sufficient to overcome the objection and rejection based on the lack of availability of biological material (see page 3 of the Office Action).

Accordingly, withdrawal of the rejection of the claims under 35 U.S.C. §112, first paragraph is respectfully requested.

In re Application of:  
Fenical et al.  
Application No.: 09/991,518  
Filed: November 16, 2001  
Page 11

PATENT  
Attorney Docket No.: UCSD1630-1

### Conclusion


A substitute Sequence Listing is submitted herewith. The substitute Sequence Listing shows sequences that were present in the subject application as filed and, therefore, does not add new matter.

Applicants submit that the pending claims are in condition for allowance. Reexamination, reconsideration, withdrawal of the rejections, and early indication of allowance are requested respectfully. If any questions remain, the Examiner is urged to contact the undersigned below.

No fee is believed due in connection with this Amendment. If any additional fees are due, the Commissioner is hereby authorized to charge any fees that may be required by this paper to Deposit Account No. 07-1896. A duplicate copy of this Transmittal Sheet is attached.

Respectfully submitted,

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